

- (2) provide an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications.

Applicants have reviewed all claims in the co-pending applications. Applicants herein comply with option (3) of the Administrative Requirement.

The Examiner has informed Applicants that the Office has determined the allowed claims to be patentably distinct from the claims of Applicants' issued patents: U.S. Patents Nos. 4,694,490, 4,704,725, 4965, 5,109,414, 5,233,654, 5,335,277 and 5,887,253. To Applicants' understanding, the purpose of their compliance with the Administrative Requirement is to relieve the Examiner from the need to make the obviousness-type double patenting analysis between the allowed claims and the presently pending claims in the co-pending applications and shift that burden to Applicants. Accordingly, Applicants comply with the Administrative Requirement by stating the bases upon which they made the required double patenting analysis.

"The purpose of this [double patenting] rejection is to prevent the extension of the term of a patent, even where an express statutory basis for the rejection is missing, by prohibiting the issuance of the claims in a second patent not patentably distinct from the claims of the first patent." *In re Longi*, 759 F.2d 887, 891, 225 U.S.P.Q. 645, 648 (Fed. Cir. 1985). Thus, Applicants' compliance with the Administrative Requirement is intended to prevent the issuance of claims in a second patent not patentably distinct from the allowed claims which will issue from this patent application. Accordingly, Applicants set forth below why the claims **currently pending** in each of the copending applications are patentably distinct from the presently allowed claims. Applicants have identified limitations in each of the present claims of the co-pending applications that are not

taught or suggested by the presently allowed claims. The cited limitations are not an exhaustive list of the limitations in the co-pending applications not taught by the presently allowed claims.

Further, Applicants' analysis of the claims of the co-pending applications is based on the claims as they presently exist in each application including any proposed amendments presented before the Examiners handling those applications. Should the claims in the co-pending applications be further amended, Applicants may rely on different limitations to maintain that such amended claims are patentably distinct from the allowed claims or Applicants may file a terminal disclaimer in such an amended application. For the reasons set forth below, the pending claims of each of the co-pending applications are patentably distinct from the presently allowed claims.

#### IDENTIFICATION HOW CLAIMS ARE DISTINCT AND SEPARATE

Applicants identify below how all the claims in the co-pending applications are patentable distinct from the presently allowed claims.

The instant application is generally directed to delivering receiver-specific programming, for example, combined medium programming. The particular teaching of the allowed claims does not teach or suggest each limitation of the claims of the co-pending applications as set forth below.

- The claims of Application Ser. No. 08/113,329 are generally directed to control of the communication of television and/or signals, for example at transmitter stations and especially intermediate transmission stations. Each of the claims of Application Ser. No. 08/113,329 includes at least one limitation directed to programming schedules or sources, signals that identify units of television programming, recorder/players, signals designated for delayed retransmission, control instructions for control of communication of programming, or determining a channel or frequency for transmission.
- The claims of Application Ser. No. 08/397,636 are generally directed to storing data and programming. Each of the claims of Application Ser. No. 08/397,636 includes at least one limitation directed to storing programming at multiple locations; multiple storage devices or locations; programming intermediate stations; locating storage space; storing control signals; or

storing instruct signals that control communication of programming or operate to select and control communication of an identifier.

- The claims of Application Ser. No. 08/441,701 are generally directed to assembling records of signal use, for example, for communication to remote stations. Each of the claims of Application Ser. No. 08/441,701 includes at least one limitation directed to gathering statistics, creating or assembling a record, or communicating a record to a remote source.
- The claims of Application Ser. No. 08/442,383 are generally directed to communication of operating instructions. Each of the claims of Application Ser. No. 08/442,383 includes at least one limitation directed to queries for reprogramming, communicating an event signal, or transferring a record of identification.
- The claims of Application Ser. No. 08/444,758 are generally directed to network automation. Each of the claims of Application Ser. No. 08/444,758 includes at least one limitation directed to programming schedules, scheduling a time or channel for transmission, control of transmitter stations, data effective to effect an intermediate transmission station to receive and store programming, storage means for storing data of predetermined capacities, modifying signals, communicating before a specific time, control of transfer devices, or delay or retransmission of programming or programming organized for transmission.
- The claims of Application Ser. No. 08/444,788 are generally directed to transmitter station functionality. Each of the claims of Application Ser. No. 08/444,788 includes at least one limitation directed to inputting or receiving a schedule.
- The claims of Application Ser. No. 08/445,328 are generally directed to transmission operations. Each of the claims of Application Ser. No. 08/445,328 includes at least one limitation directed to controlling a selective transfer device to communicate at least one processor instruction and transmitting the processor instruction, generating for transmission a signal which includes executable code, controlling a selective transfer device at a transmitter station to communicate computer code based on a schedule, controlling a selective transfer device at a transmitter station to combine one of computer code and a program module with image information in a signal for transmission, a memory or recorder operatively connected to a transmitter for storing and communicating a control signal which operates at a receiver station, receiving and storing and

causing to be communicated to a transmitter at a specific time a control signal which operates at a receiver station, receiving a second control signal which operates at a transmitter station to communicate a first control signal to a transmitter, or one of 1) adding computer code to and 2) embedding computer code in a signal containing video, audio, and graphic information.

- The claims of Application Ser. No. 08/446,553 are generally directed to budgeting at a receiver station. Each of the claims of Application Ser. No. 08/446,553 includes at least one limitation directed to generating or selecting budget data, delivering a user specific budget, receiving or processing an instruction which is effective to generate and communicate to a remote station a datum of a budget, generating a projected value in response to a control signal in respect of a budget, or receiving an instruct signal which is effective to deliver a user specific projected value of a product or service.
- The claims of Applications Ser. No. 08/447,447 are generally directed to generation of information in a network. Each of the claims of Application Ser. No. 08/447,447 includes at least one limitation directed to generating downloadable code or a generation instruction or processing instructions or a generation control signal, or generating at an intermediate transmission station information content of a second signal to be transmitted.
- The claims of Application Ser. No. 08/447,496 are generally directed to subscriber response, for example to a recommendation. Each of the claims of Application Ser. No. 08/447,496 includes at least one limitation directed to receiving a subscriber input after a step of delivering or responsively to a recommendation or receiving a subscriber response to delivered audio or video.
- The claims of Application Ser. No. 08/446,431 are generally directed to selection of subscriber data and control of an output of a presentation of mass medium programming and selected subscriber information. Each of the independent claims of Application Ser. No. 08/446,431 includes at least one limitation directed to receiving or detecting an instruct signal pertaining to subscriber data.
- The claims of Application Ser. No. 08/447,908 are generally directed to programming or reprogramming a receiver station and/or communication of operating system instructions. Each of the claims of Application Ser. No. 08/447,908 includes at least one limitation directed to a specific or designated version or type of programmable device present at a receiver station.

- The claims of Application Ser. No. 08/447,974 are directed to scheduled operations. Each of the claims of Application Ser. No. 08/447,974 includes at least one limitation directed to instruction signals used to generate a schedule or a portion of such a schedule.
- The claims of Application Ser. No. 08/448,251 are generally directed to formulating policy and/or plan information, networks and stations for these purposes, and control and communication functionalities for these purposes. Each of the claims of Application Ser. No. 08/448,251 includes at least one limitation directed to presentation, explanation or modification of plans, including master plans, and policies; policy and plan control signals, generally applicable information of policies and plans, and of control signals, to be formulated; variables, ingredients or generally applicable information of solutions for use in policies; solution functionalities; planning information; functionalities for prompting a user regarding plans or policies or outputting information to influence a user regarding plans or policies.
- The claims of Application Ser. No. 08/448,326 are generally directed to network control functionalities. Each of the claims of Application Ser. No. 08/448,326 includes at least one limitation directed to selecting, communicating and transmitting a control signal in accordance with a control signal transmission schedule and controlling the network based on the control signal.
- The claims of Application Ser. No. 08/448,644 are generally directed to synchronizing operations. Each of the claims of Application Ser. No. 08/448,644 includes at least one limitation directed to valve control signals, processor interrupt signals or synchronizing control signals; control of processors to commence waiting for input; multiple processors, such as on a single chip, and control thereof; or multiple buffers, such as on a single chip, and routing data thereto selectively.
- The claims of Application Ser. No. 08/449,097 are generally directed to processor control functionality. Each of the claims of Application Ser. No. 08/449,097 includes at least one limitation directed to a plurality of processors that operate simultaneously to process a message or a message stream; control of such a plurality of processors, for example by a control processor; control based on processor register memory or flag memory contents or control function invoking information; communicating a processor interrupt; controlling a digital switch; or generation of control information at transmitter stations.

- The claims of Application Ser. No. 08/449,263 are generally directed to the decryption of information. Each of the claims of Application Ser. No. 08/449,263 includes at least one limitation directed to decryption.
- The claims of Application Ser. No. 08/449,523 are generally directed to receiver operations. Each of the claims of Application Ser. No. 08/449,523 includes at least one limitation directed to 1) variable transmission formats or signaling schemes or 2) selecting and processing a portion of a transmission to extract information about a control signal.
- The claims of Application Ser. No. 08/452,395 are generally directed to metering. Each of the claims of Application Ser. No. 08/452,395 includes at least one limitation directed to metering information such as information on passing of control signals or identified signals, records of use, storing at least one identifying signal, results of comparing, evidence of functions performed or controlled, billing records, or receiving data that reflect local use.
- The claims of Application Ser. No. 08/459,216 are generally directed to navigation to a desired program. Each of the claims of Application 08/459,216 includes at least one limitation directed to identifying programming from a plurality of television programs or multichannel signals; generating control signals; controlling a tuner; generating, processing, detecting or decoding program identification signals or digital information; information regarding program availability; comparisons of identification signals; selecting specific signals on the basis of comparing, recording a program, tuning to receive programming, receiving input from subscriber regarding program, processing received information to identify a program, or detecting identification information.
- The claims of Application Ser. No. 08/459,521 are generally directed to assembly of code or data modules. Each of the claims of Application Ser. No. 08/459,521 includes at least one limitation directed to completing or processing a instruction module, code module or data module; higher language computer code; incomplete processor instructions; or assembling computer instructions in accordance with computer code.
- The claims of Application Ser. No. 08/459,522 are generally directed to messaging systems. Each of claims of Application Ser. No. 08/459,522 includes at least one limitation directed to generating a message or a portion of a message stream; an execution segment, meter-monitor

segment, length tokens, format fields and/or cadence information; multiple message formats or functions; multiple message components; messages of variable length; or assembling records.

- The claims of Application Ser. No. 08/459,788 are generally directed to error correction. Each of the claims of Applications Ser. No. 08/459,788 includes at least one limitation directed to one or more failure handling routines.
- The claims of Application Ser. No. 08/460,711 are generally directed to digital television systems. Each of the claims of Application Ser. No. 08/460,711 includes at least one limitation directed to digital television or video signals.
- The claims of Application Ser. No. 08/460,770 are generally directed to downloadable code. Each of the claims of Applications Ser. No. 08/460,770 includes limitation directed to executing an executable or computer program, computing a variable value in response to a control signal, generating instruction modules or instruction sets, or outputting personalized advertising.
- The claims of Application Ser. No. 08/460,817 are directed to network processing and communications. Each of the claims of Application Ser. No. 08/460,817 includes at least one limitation directed to; generating, assembling, selecting, or storing data, messages or instructions at transmitter stations; storing or selecting programming or control signals at transmitter stations; program schedules; storing or selecting software; storing an intermediate generation set or a program instruction set; generating or assembling some of a processor instruction or a message or code or a control signal or an instruct signal; selecting computer code; storing computer processing code; receiving only some of a control signal; transmitting from a receiver station to a remote station a datum designating programming or output; processing a subscriber reaction; transferring or communicating software to at least one storage location.
- The claims of Application Ser. No. 08/466,894 are generally directed to combined control of network and receiver operations. Each of the claims of Application Ser. No. 08/446,894 includes at least one limitation directed statistics on programming availability use or usage, outputting to a remote location, delaying communication or processing, or transmission schedules
- The claims of Application Ser. No. 08/469,612 are generally directed to switching operations. Each of the claims of Application Ser. No. 08/469,612 includes at least one limitation directed to selecting signals for reception.

- The claims of Application Ser. No. 08/470,051 are generally directed to downloadable code. Each of the claims of Application Ser. No. 08/470,051 includes at least one limitation directed to executing an executable program, receiving at a transmitter station a control signal that executes downloadable processor instructions or a different one of downloadable processor instructions.
- The claims of Application Ser. No. 08/470,571 are generally directed to integrating remotely originated and locally generated data. Each of the claims of Application Ser. No. 08/470,571 includes at least one limitation directed to contacting a remote data source, transmitting a control signal from an origination transmitter to a remote intermediate transmitter station before a specific time, transmitting a first discrete signal and a second discrete signal, or organizing information in discrete signals to provide an organized signal.
- The claims of Application Ser. No. 08/472,066 are generally directed to telephone communications. Each of the claims of Application Ser. 08/474,066 includes at least one limitation directed to telephone communications.
- The claims of Application Ser. No. 08/473,484 are generally directed to broadcast control of receiver stations. Each of the claims of Application Ser. No. 08/473,484 includes at least one limitation directed to selecting device or apparatus to be controlled, selecting functions to be performed, or altering or modifying a control signal.
- The claims of Application Ser. No. 08/474,145 are generally directed to the decryption of information. Each of the claims of Application Ser. No. 08/474,145 includes at least one limitation directed to decryption or disabling functionality or communicating appearance-of-tampering information or enabling.
- The claims of Application Ser. No. 08/474,146 are generally directed to storing programming for playback. Each of the claims of Application Ser. No. 08/474,146 includes limitation directed to storing a programming signal including video or a television signal or a program and an instruction.
- The claims of Application Ser. No. 08/474,964 are generally directed to collecting and reporting information in a network. Each of the claims of Application Ser. No. 08/474,964 include at least one limitations directed to promulgating a query, transferring a record of a function performed, transmitting a control signal designating a receiver station in which an instruct signal is



addressed, reporting use of a computer programming feature, or communicating a datum to a remote station.

- The claims of Application Ser. No. 08/477,547 are generally directed to communicating subscriber station information to a remote station. Each of the claims of Application Ser. No. 08/477,547 includes at least one limitation directed to transferring one or more data to a remote station.
- The claims of Application Ser. No. 08/477,711 are generally directed to control of signal embedding. Each of the claims of Applications Ser. No. 08/477,711 includes at least one limitation directed to an instruct-to-embed signal.
- The claims of Application Ser. No. 08/477,805 are generally directed to network automation, more specifically controlling a remote or intermediate transmitter station. Each of the claims of Applications Ser. No. 08/477,805 includes at least one limitation directed to programming schedules, storing a programming schedule at the remote transmitter station, comparing a signal to a programming schedule stored at the intermediate transmitter station, or comparing a signal to the stored programming schedule at the intermediate transmitter station.
- The claims of Application Ser. No. 08/478,544 are directed to control of display of television programming. Each of the claims of Application Ser. No 08/487,544 includes at least one limitation directed to storing a program identifier, originating a second signal that also identifies television programming, or storing a generated television image.
- The claims of Application Ser. No. 08/479,215 are generally directed to receiving user responses. Each of the claims of Application Ser. No. 08/479,215 includes at least one limitation directed to prompting a user; receiving user input in response to programming, an offer or a solicitation; or authorizing action such as delivery of a product or service.
- The claims of Application Ser. No. 08/479,374 are generally directed to controlling station memory. Each of the claims of Application Ser. No. 08/479,374 includes at least one limitation directed to a clear-and-continue or instruct-to-clear signal, clearing and image, or clearing a memory.
- The claims of Application Ser. No. 08/480,392 are generally directed to storing data and programming. Each of the claims of Application Ser. No. 08/480,392 includes at least one

limitation directed to; locating storage space; storing programming at a storage location; storing an intermediate generation set of transmission information; storing programming comprising a computer program and a portion to be completed; or communicating an information transmission to a storage location.

- The claims of Application Ser. No. 08/482,857 are generally directed to processing selected portions of a transmission. Each of the claims of Application Ser. No. 08/482,857 includes at least one limitation directed to varying the amount of a signal searched or an expanded or contracted code portion of a signal.
- The claims of Application Ser. No. 08/483,169 are generally directed to presenting solutions to problems. Each of the claims of Application Ser. No. 08/483,169 includes at least one limitation directed to processing problems, solutions or recommendations; generating at least some of a solution, recommendation or analysis; recommending action; receiving a subscriber reaction to a solution or recommendation or in respect of a problem; explaining a solution; or transferring subscriber data to a remote station.
- The claims of Application Ser. No. 08/485,283 are generally directed to receiving user responses. Each of the claims of Application Ser. No. 08/485,283 includes at least one limitation directed to prompting a subscriber for a reply; receiving viewer response, subscriber reply, user reply, or inputting a subscriber order in response to programming, an offer or a solicitation.
- The claims of Application Ser. No. 08/486,258 are generally directed to timing and the coordination of a presentation. Each of the claims of Application Ser. No. 08/486,258 includes at least one limitation directed communicating or outputting a user information with a portion of mass medium or video programming of specific relevance. Each of the claims also includes the limitation of receiving user instruction after receiving programming data.
- The claims of Application Ser. No. 08/487,397 are generally directed to programming distribution. Each of the claims of Application Ser. No. 08/487,397 includes at least one limitation directed to control of intermediate transmitter stations, selecting a destination device and communicating programming to the destination device, retransmitting a unit of programming, or transmitting a retransmission control signal.

- The claims of Application Ser. No. 08/487,410 are generally directed to preventing the display of incomplete images. Each of the claims of Application 08/487,410 includes at least one limitation directed to clearing a portion of memory of an incomplete image, advancing to subsequent information in an information transmission, or originating an instruct signal which enables a transmitter station to originate a control signal.
- The claims of Application Ser. No. 08/487,411 are generally directed to financial analysis. Each of the claims of Application 08/487,411 includes at least one limitation directed to a generating a financial analysis, presenting a user specific financial analysis, receiving viewer or planner modified information for use in a subsequent iteration of processing instruct signal, or storing an instruct signal operative to deliver a user specific financial analysis.
- The claims of Application Ser. No. 08/487,526 are generally directed to outputting or presenting multimedia presentations. Each of the claims of Application Ser. No. 08/487,526 includes an least one limitation directed to coordinating presentation, controlling a station to enable a coordinated presentation, identifying content of a first and content of a second of two media identifying content of a first medium to be output in a multimedia presentation, receiving a user response base on outputting a signal, or performing these functions with a microcomputer.
- The claims of Application Ser. No. 08/487,536 are generally directed to transmission operations. Each of the claims of Applications Ser. No. 08/487,536 includes at least one limitation directed to controlling a switch to communicate programming according to a timing instruction, signal stripping or generating, controlling a signal generator to add a second signal to a communicated first signal.
- The claims of Application Ser. No. 08/488,383 are generally directed to the presentation of advertising. Each of the claims of Application Ser. No. 08/488,383 includes at least one limitation directed to outputting personalized advertising, generating a value datum or selecting mass medium programming based on a value datum, storing an instruct signal at a transmitter station, or transmitting an instruct signal which is effective at a receiver station to compute a datum and out benefit information based on the datum.

- The claims of Application Ser. No. 08/498,002 are generally directed to processing depending on the status of a television display. Each of the claims of Application Ser. No. 08/498,002 includes at least one limitation directed to detecting whether a television is on.
- The claims of Application Ser. No. 08/511,491 are generally directed to generation of data or signals at receiver stations. Each of the claims Application Ser. No. 08/511,491 includes at least one limitation directed to 1) controlling a receiver station to generate or select a receiver specific datum and present a receiver specific datum simultaneously or sequentially with mass medium programming that explains or makes apparent a meaning of the receiver specific datum or 2) storing an instruct signal at a transmitter station which is operative at a receiver station to cause a programmable processor to generate television output which completes or supplements a television program.

As each of the claims the co-pending applications includes limitations not taught or suggested by the presently allowed claims, the claims of each of the co-pending applications are separate and distinct from the presently allowed claims. Accordingly, there are no conflicts between the co-pending applications and the instant application. As Applicants have identified how the co-pending applications are separate and distinct from the presently allowed claims, Applicants have complied with the Administrative Requirement. Accordingly, this application is in condition for allowance.

## SUMMARY OF INTERVIEWS

MAY 4, 2009

The prosecution of this application, along with all but two of Applicants' copending application, was suspended for several years pending the outcome of the appeal of Application Serial Nos. 08/470,571 and 08/487,526 and the reexamination proceedings of seven related patents. Applicants inquired into the status of these applications in January, 2009, as the current six-month suspension period expired. Applicants requested that the suspension of these applications not be renewed. The Office, through Supervisory Examiner David L. Ometz indicated that the suspensions would not be renewed and that prosecution would recommence. Applicants wish to thank Examiner David L. Ometz for the courtesy of the interview held on May 4, 2009 in which

Applicants' representatives and the Examiners discussed an overall plan for examination of the remaining 110 applications which relate to this application and have a common chain of priority. Applicants were informed that the Patent and Trademark Office (PTO) was developing a plan to resume examination and that Applicants would be informed when the plan was in place.

JULY 22, 2009

Applicants were informed in July, 2009, that a team of examiners had been assembled to examine Applicants' copending applications. Applicants appreciate the courtesies extended to Applicants' Representatives in a meeting held July 22, 2009, with the examination team. In attendance at the meeting were Thomas J. Scott, Jr. and Carl L. Benson, of Goodwin Procter and the PTO personnel identified on the attached list. Applicants' representatives made a presentation to the Examiners in attendance in accordance with the attached agenda and provided the materials attached hereto to the Examiners for their consideration and use in the further examination of this application and the other application related to this application as identified in Tab 2 of the materials provided to the Examiners in the meeting. Applicants' representatives agreed to respond to any telephone inquiries or to be present for personal interview at the PTO in any circumstance where the Examiner believed such an interview would advance the prosecution of this application.

SEPTEMBER 30, 2009

Applicant and Examiner agreed to amend the Claims 55 and 78 steps d (1-4) to include the language "step for" and add "step for" language to positively recite in the "delivery step" of the "wherein" clause of the step d-4, thereby invoking §112 ¶6. Additionally, the Applicants agreed to add the following statement on the first line of the body of the claim's language to overcome any 35 U.S.C. § 101 issues: "using a computer to perform the following steps of". Applicants expressly reserved the rights to present other claims if they believe it to be appropriate.

**CONCLUSION**

Applicants have resolved all conflicts between the claims each of Applicants' fifty-five co-pending applications and the presently allowed claims in compliance with the Administrative Requirement. In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: December 23, 2009

Respectfully submitted,

By/s/ Thomas J. Scott, Jr.

Thomas J. Scott, Jr.

Registration No.: 27,836  
GOODWIN PROCTER LLP  
901 New York Avenue, NW  
Washington, DC 20001  
(202) 346-4000  
Attorney for Applicants